

Appl. No. : **09/993,874**
Filed : **November 14, 2001**

one of skill in the art would recognize that the spectrum of Figure 3, together with the textual references to where the spectrum was “centered,” indicated possession of a nucleic acid molecule encoding a luciferase having a bioluminescence spectrum “having a maximum λ of approximately 549 nm.” The specification thus describes the luciferase encoded by the invention both as having a “ $\lambda_{max}=549$ nm” and more broadly as having a maximum of the electromagnetic spectrum approximately in the region of 549 nm. Applicant submits that both descriptions of the spectrum can be found in the originally-filed specification, and that Applicant should not be limited to the more restrictive description based on a lack of written description.

In this respect, this situation is very similar to that the Federal Circuit considered in Cooper Cameron. In that case, the text of the specification described the location of a claimed workover port as “between the plugs,” and the district court held that a claim that located the port “below the BOP bore and above [the] tubing hanger,” but did not require the port to be “between the plugs,” was invalid for failure to meet the written description requirement. Cooper Cameron, 291 F.3d at 1319-20. The Federal Circuit reversed. It noted that an originally-filed drawing from the patent depicted the workover port at the claimed location. The court held that that drawing alone was sufficient support for the claimed limitation:

Although the specification also describes an arrangement that may be claimed in another way (*i.e.*, “between the plugs”), and explains why the invention functions well when arranged accordingly, the specification is not limited to that particular description. An inventor is entitled to claim his invention in more than one way.

Id. at 1322 (emphasis added).

In this case, as in Cooper Cameron, Applicant has described the invention in two ways: one set forth in haec verba in the text of the specification, and one that the skilled artisan would understand from a drawing together with textual references. The Examiner has, like the district court judge in Cooper Cameron, recognized only the former, and has rejected a claim limitation directed to the latter as lacking written description support. Applicant submits that under Cooper Cameron, the Examiner’s rejection is untenable, and respectfully requests that the rejection of the pending claims for lack of written description support be withdrawn.

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

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The Examiner has maintained her rejection of Claims 1, 7, and 8 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because of the Examiner's view that “[t]he metes and bounds of the term ‘approximately’ are not defined in the specification and can mean different ranges in the art.” Applicant submits that in view of originally-filed Figure 3, the metes and bounds of the claim limitation “a maximum λ of approximately 549 nm” are clear: they are those that would be understood at a glance by one of skill in the art from the emission spectrum shown in Figure 3.

It is clear that the mere presence of a term such as “approximately” or “about” in a claim limitation does not by itself render the limitation indefinite. See W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1557 (Fed. Cir. 1983) (holding that a claim limitation defining the stretch rate of a plastic as “exceeding about 10% per second” was not indefinite where “[i]nfringement [was] clearly assessable through use of a stopwatch”); Ex parte Eastwood, 163 U.S.P.Q. 316, 317 (Bd. Pat. App. & Interferences 1968) (“The descriptive word “about” is not indefinite Rather, the term is clear but flexible and is deemed to be similar in meaning to terms such as ‘approximately’ or ‘nearly’.”); M.P.E.P. § 2173.05(b)(A) (citing Gore and Eastwood). The meaning of such terms is “dependent on the facts of a case, the nature of the invention, and the knowledge imparted by the totality of the earlier disclosure to those skilled in the art.” Eiselstein v. Frank, 52 F.3d 1035, 1040 (Fed. Cir. 1995).

It is true that the courts have on occasion held that claim limitations employing words such as “approximately” or “about” were indefinite. See Amgen, Inc. v. Chugai Pharm. Co., Ltd., 927 F.2d 1200, 1218 (Fed. Cir. 1991). However, these cases relied on the lack of any disclosure in the specification indicating what scope of protection the words were intended to provide. See id. (holding the limitation “at least about 160,000” to be indefinite where “nothing in the specification, the prosecution history, or prior art provides any indication as to what range of specific activity is covered by the term ‘about’”); cf. Quantum Corp. v. Rodime, PLC, 65 F.3d 1577, 1581 (Fed. Cir. 1995) (holding that the addition of “approximately” constituted new matter where there was “no evidence to show that one skilled in the art understood ‘at least 600 tpi’ to be the same as ‘at least approximately 600 tpi’ or that the patentee defined it as such in the patent or during prosecution”).

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In contrast, in the present application Figure 3 provides a clear indication of the scope of protection sought for the “maximum λ of approximately 549 nm” limitation. Indeed, Applicant was so concerned about clearly disclosing the maximum wavelength of the light emitted by the protein produced from the claimed nucleic acid sequences that he included a picture of the emitted wavelengths. It would be difficult to be more definite. Applicant submits that the totality of the disclosure, including the picture of the emitted wavelengths shown in Figure 3, clearly and definitely shows those of skill in the art that the maximum wavelength was not a spike at 549 nm, as the Examiner implies, but was rather a broad peak approximately centered at 549 nm. In view of the breadth of Applicant’s disclosure, he submits that he should not be limited to a narrow claim scope on definiteness grounds. Cf. Eiselstein, 52 F.3d at 1040 (“Eiselstein need not be bound to maximum precision for the nickel content when the whole tenor of his disclosure indicates approximation.”) In view of this, Applicant submits that the Examiner’s rejection of the “maximum λ of approximately 549 nm” limitation as indefinite is improper and should be withdrawn.

CONCLUSION

In light of the foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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